



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,198	01/16/2004	Nobuyuki Tonegawa	00862.023404.	4895

5514 7590 03/25/2010
FITZPATRICK CELLA HARPER & SCINTO
1290 Avenue of the Americas
NEW YORK, NY 10104-3800

EXAMINER

RILEY, MARCUS T

ART UNIT	PAPER NUMBER
----------	--------------

2625

MAIL DATE	DELIVERY MODE
-----------	---------------

03/25/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/758,198	TONEGAWA, NOBUYUKI	
	Examiner	Art Unit	
	MARCUS T. RILEY	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 15 December 2009.
- 2a) This action is **FINAL**.
- 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-11 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-11 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 16 January 2004 is/are: a) accepted or b) objected to by the Examiner.
 - Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 - Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 - 1. Certified copies of the priority documents have been received.
 - 2. Certified copies of the priority documents have been received in Application No. _____.
 - 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 07/09/2008.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application
- 6) Other: _____.

Art Unit: 2625

DETAILED ACTION

Response to Amendment

1. This office action is responsive to applicant's remarks received on December 15, 2009.

Claims 1-11 remain pending.

Response to Arguments

2. Applicant's arguments filed with respect to amended **claims 1, 2, 6, 7 & 9 - 11** filed on December 15, 2009 have been fully considered but they are not persuasive.

A: Applicant's Remarks

For Applicant's remarks see "*Applicant Arguments/Remarks Made in an Amendment*" filed December 15, 2009.

A: Examiner's Response

Applicant argues that Nagashima does not disclose or suggest a registration unit for registering distinct application data and print data and that Nagashima cannot be understood to anticipate or suggest the distinctly claimed application data and print data that are input and registered in amended independent claims 1 and 9-11. Applicant also argues, the process of Nagashima cannot be understood to anticipate the claimed selection unit or steps, that include selecting "the application data, but not the print data" in accordance with a specific index and a designated transmission unit or step, as recited in independent claims 1 and 9-11 nor controlling

Art Unit: 2625

a “transmission unit” in addition to a “printing unit” as further recited in independent claims 1 and 9-11. In sum Applicant argues, that Nagashima does not disclose or suggest an information processing apparatus, method, or computer-related program, that accepts two types of data, namely the application data and print data, and effects different processing for the application printer as recited in amended independent claims 1 and 9-11.

Examiner understands Applicant’s arguments but respectfully disagree. Nagashima does disclose or suggest a registration unit for registering distinct application data and print data and can be understood to anticipate or suggest the distinctly claimed application data and print data that are input and registered. Nagashima discloses the registration unit at Fig. 2, #1073. It is configured to register the application data and the print data in the Information Management DB. Fig. 2 shows two coversheet template registration files are stored in an information management database DB. The coversheet includes print data and application data as explained in Paragraph 0032 and Paragraph 0063. Figs. 6 & 7 is a diagram showing the structure of files stored in the registration file A & B respectively. Thus, Nagashima can be understood to anticipate or suggest the distinctly claimed application data and print data that are input and registered.

The process of Nagashima can be understood to anticipate the claimed selection unit or steps, that include selecting “the application data, but not the print data” in accordance with a specific index and a designated transmission unit or step and controlling a “transmission unit” in addition to a “printing unit”. Fig. 3, Steps S3 and S4 shows the process of generation, registration and selection. The coversheet generating section 1072 carries out the printing process. In the printing process, a coversheet template is registered first in a step S3, and a coversheet template is then selected in a step S4. The coversheet includes application data and print data as stated in

Art Unit: 2625

Paragraph 0032 and Paragraph 0063. Paragraph 0056 explains where the printer driver of Data Control Section 1070, not shown, sends data to a designated address. The printer driver is a program that processes printing data generated by an application or the like so that the printing data can be processed by a printer. Thus, process of Nagashima can be understood to anticipate the claimed selection unit or steps.

As a result, Nagashima discloses or suggests an information processing apparatus, method, or computer-related program, that accepts two types of data, namely the application data and print data, and effects different processing for the application printer as recited in amended independent claims 1 and 9-11. Thus, Applicant's Application is not in condition for allowance.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. **Claims 1, 2 & 6-11** are rejected under 35 U.S.C. 102(b) as being anticipated by Nagashima '202 (US 2002/0122202 A1 hereinafter, Nagashima '202).

Art Unit: 2625

Regarding claim 1; Nagashima '202 discloses an image processing apparatus (Fig. 1, #1000) comprising: first input unit (Fig. 1, #1020) configured to input application data created by predetermined application software (Fig. 3, Step S1, Page 4, Paragraph 0059);

second input unit (Fig. 1, #1030) configured to input print data (Fig. 3, Step S2, Page 4, Paragraphs 0059-0061 and Page 5, Paragraph 0063);

the print data being generated by converting the application data (i.e. The printer driver is a program that processes printing data generated by an application or the like so that the printing data can be processed by a printer. Page 4, Paragraph 0056);

registration unit (Fig. 2, #1073) configured to register the application data and the print data (Fig. 2, Registration Files A&B) in a database (Fig. 2, Information Management DB) in correspondence with a specific index (i.e. Fig. 6 & 7 where Fig. 6 & 7 is a diagram showing the structure of files stored in the registration file A & B respectively);

wherein the application data and the print data are registered in the database simultaneously but individually (i.e. Fig. 2 shows two coversheet template registration files are stored in an information management database DB. The coversheet includes print data and application data. Page 3, Paragraph 0032 and Page 5, Paragraph 0063);

a transmitting unit (Fig. 1, Cover Sheet Generating Section 1072,) configured to transmit data to an external apparatus (i.e. Cover Sheet Generating Section generates data to be transmitted to the printing apparatus 2000 or 3000. Page 4, Paragraph 0058);

a printing unit (Fig. 1, Printers 2000 or 3000) configured to perform print processing based on data (i.e. Printing data is generated with a coversheet and the generated printing data is printed by the printing apparatus 2000 or is transmitted to the printing apparatus 3000. Page 4, Paragraph 0058);

Art Unit: 2625

designation unit (Fig. 1, Printer Driver of Data Control Section 1070 - Not Shown) configured to designate said transmitting unit or said printing unit as an output method of data (i.e. The printer driver sends data to a designated address. The printer driver is a program that processes printing data generated by an application or the like so that the printing data can be processed by a printer. Page 4, Paragraph 0056);

index input unit (Fig. 1, Coversheet Template Producing Section 1071) configured to input the specific index (Fig. 4 Steps S300-S307. Page 5, Paragraph 0063-0069);

and a selecting unit (Fig. 3, Step S4) configured to select the application data, but not the print data, corresponding to the specific index input by said index input unit in a case where the specific index is input by said index input unit said transmitting unit is designated by said designation unit, and to select the print data, but not the application data, corresponding to the specific index input by said index input unit in a case where said printing unit is designated by said designation unit; and (Figs. 5A & 5B Steps S500-S511, Page 6, Paragraphs 0072-0079);

a control unit (Fig. 1, Data Control Section 1070) configured to control said transmitting unit to transmit the application data when said selecting unit selects the application data, and to control said printing unit to perform print processing based on the print data when said selecting unit selects the print data (i.e. Data Control Section 1070 controls Cover Sheet Generating Section 1072 that generates data to be transmitted to the printing apparatus 2000 or 3000. Page 4, Paragraph 0058; See also Fig. 3 Step S4 and Fig. 5 Steps S502 & S503, Page 6, Paragraph 0074);

Regarding claim 2; Nagashima '202 discloses wherein said printing unit prints an image obtained by synthesizing information representing the index and the print data input by said second input unit (Figs. 5A & 5B Steps S500-S511, Page 6, Paragraphs 0072-0079);

Art Unit: 2625

and wherein said index input unit selects the information representing the index by reading, by a reading device (Fig. 1, Storage Medium Reading Device 1050) the image which is obtained by synthesizing the information representing the index and the print data input by said second input unit and is printed by said printing unit (Figs. 5A & 5B Steps S500-S511, Page 6, Paragraphs 0072-0079. See also Page 4, Paragraph 0056).

Regarding claim 6; Nagashima '202 discloses wherein when the output method designated by said designation unit is printing by said printing unit (i.e. Data Control Section 1070 transmits data to printing apparatus 2000 or 3000 to be printed. Page 4, Paragraph 0058);

said selecting unit selects the print data and causes said printing unit to print an image based on the print data (Figs. 5A & 5B Steps S500-S511, Page 6, Paragraphs 0072-0079).

Regarding claim 7; Nagashima '202 discloses when the output method designated by said designation unit is transmission by said transmission unit, said selecting unit causes said transmission unit to transmit the application data (Fig. 3, Steps S1-Steps S7 i.e. Printing data is generated with a coversheet and the generated printing data is printed by the printing apparatus 2000 or is transmitted to the printing apparatus 3000. Page 4, Paragraph 0058).

Regarding claim 8; Nagashima '202 discloses where the database is constructed by a terminal connected via a network (i.e. Fig. 1 Communication Network 4000, Page 4, Paragraphs 0051-0054).

Regarding claim 9-11; Claims 9-11 contain substantially the same subject matter as claim 1. Therefore, claim 9-11 are rejected on the same grounds as claim 1.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 3-5** are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagashima '202 (US 2002/0122202 A1 hereinafter, Nagashima '202) in combination with Ett (US 5,227,893 hereinafter, Ett '893).

Regarding claim 3; Nagashima '202 as modified does not expressly disclose where the information representing the index is expressed by a barcode.

Ett '893 discloses where the information representing the index is expressed by a barcode (See Fig. 5 where Fig. 5 shows a flow diagram for the reception of a facsimile image which contains the indexing/routing information in pseudo code bar form.).

Nagashima '202 and Ett '893 are combinable because they are from same field of endeavor of image processing apparatuses (Ett '893 at "*Summary*").

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify image processing unit as taught by Nagashima '202 by adding where the information representing the index is expressed by a barcode as taught by Ett '893. The motivation for doing so would have been to permit the embedding of data needed for indexing, or further routing, within the image in machine readable form, which is transparent to the users.

Art Unit: 2625

Therefore, it would have been obvious to combine Nagashima '202 with Ett '893 to obtain the invention as specified in claim 1.

Regarding claim 4; Ett '893 discloses where the information representing the index is expressed by a character string (i.e. Fig. 3 shows a typical string of bar codes in code 39, with a start character 78, data characters 80, a check data character 82, and a stop character 84. Column 6, lines 34-39).

Regarding claim 5; Ett '893 discloses where the information representing the index is expressed by each character spacing in a predetermined character string (i.e. Fig. 3 shows a typical string of bar codes in code 39, with a start character 78, data characters 80, a check data character 82, and a stop character 84. The start 78 and stop 84 characters are identical and contain information needed to define the widths of the bars and spaces in the ensuing code patterns. column 6, lines 34-39);

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Art Unit: 2625

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARCUS T. RILEY whose telephone number is (571)270-1581. The examiner can normally be reached on Monday - Friday, 7:30-5:00, est.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on 571-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Marcus T. Riley
Assistant Examiner
Art Unit 2625

/Marcus T Riley/
Examiner, Art Unit 2625

/David K Moore/

Application/Control Number: 10/758,198

Page 11

Art Unit: 2625

Supervisory Patent Examiner, Art Unit 2625